

Application No. 08/468,437  
Amendment dated June 28, 2004  
Reply to Office Action of December 29, 2003

REMARKS

Claims 52-63 are pending in the application; the status of the claims is as follows:

Claims 52-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,067,029 to Takahashi (“Takahashi”) in view of U.S. Patent No. 5,034,804 to Sasaki et al (“Sasaki”).

Claims 52-55 have been amended to particularly point out and distinctly claim the subject matter of the invention. Claims 64-67 have been added to provide protection for additional aspects of the invention. These changes do not introduce any new matter.

35 U.S.C. § 103(a) Rejection

The rejection of claims 52-63 under 35 U.S.C. § 103(a), as being unpatentable over Takahashi in view of Sasaki, is respectfully traversed because the references fail to teach all elements of the rejected claims.

As stated at page 3 of the Office Action,

“Takahashi fails to teaches [sic] a detector which detects whether the memory card is inserted in the card slot and detects a capacity of the inserted memory card; and the detected capacity shadows that the image information can be stored in the memory card and (b) a warning is displayed when the memory card is inserted in the card slot and the detected capacity shows that the image information cannot be stored in the memory card even if the image information can be stored in the inside memory.”

Sasaki is cited as providing the missing teaching. The Office Action states that Sasaki teaches

“a camera having a detecting means for detecting an available capacity of a memory card and connection of the memory card and generating an alarm to alert the user and permitting the image

information to be stored in the memory card when the memory card is inserted in the camera and as sufficient capacity for storing the image information and storing the image information in a memory when the memory card is not inserted in the camera or the memory capacity is not sufficient to store the image information.”.

It is respectfully submitted that Sasaki does not provide the missing teaching.

For example, Sasaki does not teach that the warning is provided *even if there is room in the internal memory to store the image*. Indeed, Sasaki teaches away from the claimed limitation. For example, Sasaki teaches to store a captured image to the buffer memory and then to check whether the memory card has sufficient capacity to store the image in the memory card. If there is insufficient memory, the image data is retained in the buffer memory, further photographing is inhibited, and a display is shown or an alarm is sounded to notify the user. Therefore, the Sasaki device provides the display or alarm only when there is insufficient room in the memory card and the buffer memory is unavailable because it already contains image data. See Fig. 10 and column 8, line 60 to column 9, line 35. In contrast, the claims require that a warning is provided even if the buffer memory is available.

With respect to claims 52 and 53, it is respectfully submitted that the combination of Takahashi and Sasaki fails to teach or suggest “a controller which controls said changer so that . . . a warning is displayed when the memory card is inserted in the card slot to store the image information therein and the detected capacity shows that the image information cannot be stored in the memory card *even if the image information can be stored in the inside memory in place of the memory card.*” Therefore, the proposed combination does not read on either claim 52 or claim 53.

With respect to claims 54 and 55, it is respectfully submitted that the combination of Takahashi and Sasaki fails to teach or suggest “a controller which controls said changer so that . . . a warning is displayed when the memory card is inserted in the card slot to store the image information therein and the remaining capacity detected by the detector is

Application No. 08/468,437  
Amendment dated June 28, 2004  
Reply to Office Action of December 29, 2003

insufficient *even if a remaining capacity of the inside memory is sufficient.*" Therefore, the proposed combination does not read on either claim 54 or claim 55.

With respect to claims 56-63, each of these claims depends from one of claims 52-54. Therefor, claims 56-63 distinguish the combination of Takahashi and Sasaki for at least the same reasons as their respective base claims.

Accordingly, it is respectfully requested that the rejection of claims 52-63 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Sasaki, be reconsidered and withdrawn.

#### CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

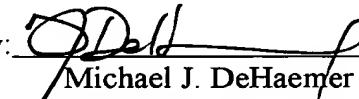
If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

Application No. 08/468,437  
Amendment dated June 28, 2004  
Reply to Office Action of December 29, 2003

and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By:   
Michael J. DeHaemer  
Registration No. 39,164  
Attorney for Applicants

MJD/lbb:bar  
SIDLEY AUSTIN BROWN & WOOD LLP  
717 N. Harwood, Suite 3400  
Dallas, Texas 75201  
Direct: (214) 981-3335  
Main: (214) 981-3300  
Facsimile: (214) 981-3400  
June 28, 2004

DA1 298442v3